REMARKS

Applicants respectfully request reconsideration of the subject application in view of the foregoing amendments and the following remarks. Claims 2-4, 6, 10, and 11 have been amended to clarify the invention. Claims 1-24 remain pending after the amendments.

Claim Objections

In the Office Action, the Examiner objected to claims 8 and 11, citing certain informalities as grounds for the objections. Applicants submit that such informalities have been corrected through the amendments above and respectfully request that the objections to claims 8 and 11 be withdrawn.

The Examiner also objected to claim 18 as appearing contradictory to the method claim. Applicants respectfully request further clarification of the grounds for objection in light of the fact that claim 18 is a system claim.

Rejections under 35 USC 112

Claims 2-4, 6-7, 10, and 20 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Regarding claim 2, the Examiner alleged that the claim is unclear because it is not clear where the application or program recited in the claim is being executed. Applicants respectfully submit that the scope of the claim can be clearly determined regardless of where the application or program is run. Nevertheless, claim 2 has been amended to clarify the invention. While the amendment does not specify a location

09/803,513   Page 8 of 13

where the application program is executed, the claim now specifies that the application or program referred to in the claim is "for invoking the Media Player." At least page 6, lines 31-32 of the specification offers full support to the amendment.

Regarding claim 3, the Examiner stated that the term "Media Player/Stream Server" is unclear. Applicant submits that claim 3 has been amended to separate the two elements Media Player and Stream Server, therefore clarifying the invention.

Claim 4 has been amended to specify that the application recited in the claim is an application for invoking the Media Player. Applicants respectfully traverse the rejection in light of the amendment.

Claim 6 has been amended to correct typographical errors therein. The claim now reads, in relevant part, "the data integrity between the media stored on the storage media and the datastore is not secured." At least page 10, lines 10-34 of the specification provides full support for that amendment.

Claim 10 has been amended to depend from claim 5. Applicants submit that the term storage media in claim 10 has an antecedent basis in claim 5.

Regarding claim 20, the Examiner stated that it is unclear what server system includes the cache. Applicant submits that the term "the server system" as recited in claim 20 clearly refers to the "server system where the Stream Server is installed," as recited in claim 17, from which claim 20 depends. Therefore, Applicants respectfully traverse the rejection of claim 20.

For at least the foregoing reasons, Applicants respectfully traverse the rejection of claims 2-4, 6-7, 10, and 20 under 35 USC 112, second paragraph.

09/803,513   Page 9 of 13

Prior Art Rejections

The Examiner rejected claims 1-6, 8-22, and 24 under 35 USC 102(a) as being anticipated by the "Icecast" document. Anticipation of a claim requires that each and every element of that claim be disclosed by a single prior art reference. Applicants respectfully traverse the anticipation rejection of claim 1 because the Icecast document does not disclose the step of "initiating transfer of the media data from the datastore to a server system on which the Stream Server selected by the Stream Server Portal is installed."

In the Office Action, the Examiner asserted that the "streamer" in the Icecast document amounted to the Stream Server of claim 1, and that the "Icecast server" amounted to the claimed Stream Server Portal. The Examiner asserted that the "initiating transfer" step in claim 1 is disclosed in the Icecast document, specifically, in the "Source" section that states that the section "lists some of the ways you have of sending data to the icecast server."

Applicants respectfully submit that, contrary to the Examiner's assertions, the Icecast document does not disclose the "initiating transfer" step because (1) the cited text in the Icecast document mentions only the sending of data, not the transfer of media data; and (2) the cited text discloses the sending of data to the alleged Stream Server Portal (i.e., the icecast server) and does not show the transfer of media data to a server system that has installed in it the Stream Server selected by the Stream Server Portal . Because the Icecast document fails to disclose (a) the transfer of media data to (a) a server system that has both the Stream Server and the Stream Server Portal

09/803,513   Page 10 of 13

installed in it, the Icecast document does not disclose each and every element of claim

1 and that claim should thus be allowed.

A prior art reference applied in an anticipation rejection must be enabling.

Applicants respectfully traverse the anticipation rejection because the Icecast document

does not constitute an enabling disclosure. Section 2121.01 of the MPEP describes the

enabling disclosure requirement for prior art references:

> "In determining that quantum of prior art disclosure which is necessary to
> declare an applicant's invention 'not novel' or 'anticipated' within section
> 102, the stated test is whether a reference contains an 'enabling
> disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA
> 1968). ">The disclosure in an assertedly anticipating reference must
> provide an enabling disclosure of the desired subject matter; mere naming
> or description of the subject matter is insufficient, if it cannot be produced
> without undue experimentation. *Elan Pharm., Inc. v. Mayo Foundation for
> Medical and Education Research*, 346 F.3d 1051, 1054, 68 USPQ2d
> 1373, 1376 (Fed. Cir. 2003) (At issue was whether a prior art reference
> enabled one of ordinary skill in the art to produce Elan's claimed
> transgenic mouse without undue experimentation. Without a disclosure
> enabling one skilled in the art to produce a transgenic mouse without
> undue experimentation, the reference would not be applicable as prior
> art.).< A reference contains an "enabling disclosure" if the public was in
> possession of the claimed invention before the date of invention. "Such
> possession is effected if one of ordinary skill in the art could have
> combined the publication's description of the invention with his [or her]
> own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d
> 531, 226 USPQ 619 (Fed. Cir. 1985).

Applicants respectfully submit that even if the Icecast document disclosed

each and every element of claim, which it doesn't, a person of ordinary skill in

the art would not be able to make and use the invention without undue

experimentation. The Icecast document does not include any drawings, for

example flowcharts, that illustrate steps in a method, or even block diagrams of

the recited server system that might be referenced to explain the claimed steps

in relation to the structural elements in the figure. Further, the text of the

09/803,513   Page 11 of 13

document itself also does not define any methodology whatsoever. For the foregoing reasons, Applicants submit that the Icecast document does not constitute a proper prior art reference under Section 2121.01 of the MPEP, and the anticipation rejection should therefore be withdrawn.

Applicants respectfully submit that claims 2-6, 8-16, 21-22, and 24 should be allowed at least by virtue of their dependency from claim 1.

Applicants respectfully traverse the rejection of claim 17 because the Icecast document does not disclose a Stream Server Controller that performs functions that include the "initiating transfer" step of claim 1. Consequently, the Icecast document does not disclose each and every element of claim 17 and that claim should be allowed. Applicants respectfully submit that claims 18-20 should also be allowed at least by virtue of their dependency from claim 17.

Claims 7 and 23 were rejected under 35 USC 103(a) as being rendered obvious by the combination of the Icecast document and U.S. Patent No. 4,007,450 to Haibt et al. ("Haibt"). Obviousness requires that the combination of references cited in a rejection teach or suggest all the limitations in the rejected claim. Applicants submit that claims 7 and 23 are not obvious because the Icecast and Haibt, either in combination or alone, fail to teach or suggest the step of "initiating transfer of the media data from the datastore to a server system on which the Stream Server selected by the Stream Server Portal is installed," which is incorporated by reference into both claims 7 and 23.

As discussed above, the Icecast document fails to disclose such step. Applicants submit that Haibt fails to cure the deficiencies of the Icecast document.

09/803,513   Page 12 of 13

In the Office Action the Examiner stated that "Haibt discloses that initiating a file transfer of updated data from a datastore to another storage media allows for rapid access to frequently used data and insuring that the updated data is current across all storage medium." Clearly, Haibt does not teach or suggest the transfer of media data to a server system in which it is installed a Stream Server selected by the Stream Server Portal. Therefore, the combination of Icecast and Haibt does not teach or suggest all of the elements in either claim 7 or 23 and consequently, those claims should be allowed.

In view of the foregoing, Applicants earnestly solicit the expedited allowance of the pending claims. The Commissioner is hereby authorized to charge any fee(s) necessary to enter this paper and any previous paper, or credit any overpayment of fees to deposit account 09-0468.

Respectfully submitted,

By: _____

Rafael A. Perez-Pineiro
Reg. No. 46,041
Phone No. (914) 945-2631

IBM Corporation
Intellectual Property Law Dept.
P. O. Box 218
Yorktown Heights, New York 10598

09/803,513   Page 13 of 13